

DT-3815



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT: Wolfgang Milewski
SERIAL NO. 09/745,645
FILED: December 12, 2000
FOR: Floor Covering of an Elastically Deformable Material
EXAMINER: Patricia L. Nordmeyer Group: 1722

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Sir:

This is a brief in support of an appeal from the Final rejection of claims 27-34 and 36-40 by the Examiner.

The Commissioner is hereby authorized to charge the fee required under 37 C.F.R. § 1.17(c) in the amount of \$165.00 and any additional fee which may be required or credit any overpayment to our Deposit Account No. 50-0955. A duplicate of this sheet is enclosed.

I. REAL PARTY IN INTEREST

The real party in interest is the inventor.

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

The present application was filed with twelve (12) claims, namely, claims 1-12. During the prosecution, claims 1-12 and subsequently added claims 13-26 were canceled. Claims 27-34 and 36-40 now present in the application for appeal purposes, claim 35 having been canceled. Claims 1-26 and 35 are canceled.

Claims 27-34 and 36-40 are pending.

IV. STATUS OF AMENDMENTS

The Final Office Action was issued on April 26, 2004. The Examiner has rejected Claims 26-29, 31-34, 36, and 3-40 under 35 U.S.C. §103(a) as being unpatentable over Stockl, U.S. Patent No. 3,699,926 (Stockl) in view of Dungl, U.S. Patent No. 4,329,981 (Dungl). The Examiner has rejected Claim 30 under 35 U.S.C. § 103(a)

as being unpatentable over Stockl in view of Dungl and further in view of Myrvold, U.S. Patent No. 5,619,832 (Myrvold). The Examiner has rejected Claims 37 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Stockl in view of Dickens et al., U.S. Patent No. 4,478,901 (Dickens).

No amendment after Final rejection has been filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates to a floor covering (1) made of an elastically deformable material and having an upper side (1a), an underside (1b), first projections (3) regularly arranged on the upper side (1b), and second projections (5) regularly arranged on the underside (1b) for supporting the floor covering on a floor (page 7, lines 2-3, 10-11; Fig. 1(a)) The first and second projections (3,5) have no overlapping regions in a plane of the floor covering, (page 7, lines 11-12, Fig. 1a).

The floor covering further has third projections (7) provided on the underside, arranged between the second projections (5), and having, in an unstressed state of the floor covering, a height smaller than a height of the second projections (page 8, lines 5-6). Thereby the third projections provide for an additional support of the floor covering on the floor when a load applied to the floor covering exceeds a

predetermined value (page 8, lines 7-9). The third projections have a load-dependent increasing characteristic line of rigidity whereby a progressive cushioning characteristic of the third projections is obtained. (page 3, lines 7-9, page 4, lines 3-5 from the bottom of the page).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

As noted above, the Examiner rejected the single independent claim 39 as being unpatentable under 35 U.S.C. §103 (a) over Stockl in view of Dungl.

The issue on Appeal is whether the combination of Stockl and Dungl indeed makes claim 39 unpatentable under 35 U.S.C. §103(a).

VII. ARGUMENTS

The Examiner asserts that Stockl discloses substantially all of the features of Claim 39, including load-dependent third projections. The Examiner admits that third projections are not apparent until stress is applied, but asserts that they are "present" at all times, even in unstressed state (Final Office Action, §4). The Examiner further asserts that the third projections in Stockl have a load-dependent increasing characteristic line of rigidity, as recited in Claim 39.

Appellants respectfully disagree with the Examiner's assertions. Firstly, applicant would like to point out that the claim limitations are always considered in static form not during an operation, and nor third projection is apparent, as it is recognized in the Office Action in the static form of the Stockl floor covering.

It is a long held view that what is not readily apparent is not obvious, and third projections in Stockl are not readily apparent in an unstressed condition of the Stockl covering (floor mat).

Generally, an "apparatus claim cover what a device *is*, not what a device *does*" (emphasis in original). *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 U.S.P.Q. 2d, 1525, 1528 (Fed. Cir. 1990). The floor mat of Stockl when considered "as is", does not have third projections, it "does" the third projections, but does not contain them.

Even assuming arguendo, that Stockl and Dungl are combined, the combination would still lack "third projections provided on the underside... and having, in an unstressed state of the floor covering a height smaller than a height of the second projections", as recited in Claim 39. In Stockl, the "third" projections have no height in the unstressed state. According to a dictionary definition

(Merriam-Webster's Collegiate Dictionary, Tenth Edition, 1998, page 538, right column), "height" is the extent of elevation above a level. In Stockl, in an unstressed state , the "third projections" have no elevation above the level of the floor mat underside.

The case law holds that "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 165 USPQ 494,496 (CCPA 1970).

Clearly, the Examiner did not consider "height" in combination with "unstressed condition".

It is respectfully submitted that a prima facie case of obviousness has not been made.

Under MPEP §2143 prima facie case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that at least the third element of prima facie obviousness has not been established.

In view of the above, it is respectfully submitted that claim 39 is patentably distinct over the combination of Stockl and Dingl and is allowable.

Claims 27-34, 36-38, and 40 depend on Claim 39, directly or indirectly, and are allowable as being dependant on an allowable subject matter.

CONCLUSION

In view of the foregoing, Appellant respectfully submits that the rejection of Claims 26-29, 31-34 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Stockl, U.S. Patent No. 3,699,926 (Stockl) in view of Dungl, U.S. Patent No. 4,329,981 (Dungl), Claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Stockl in view of Dungl and further in view of Myrvold, U.S. Patent No. 5,619,832

(Myrvold), and Claims 37 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Stockl in view of Dickens et al., U.S. Patent No. 4,478,901 (Dickens) is improper, and Appellant respectfully requests that this rejection be reversed.

Respectfully submitted,

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Dated: September 30, 2004

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail and addressed to:
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on
September 30, 2004.

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APPENDIX "A"

Claims on Appeal:

27. A floor covering according to Claim 39, wherein the first projections essentially have the shape of a spherical segment.
28. A floor covering according to Claim 39, wherein at least one of the second and third projections have a shape of one of a flat square prism and a frustum.
29. A floor covering according to Claim 39, wherein at least one of the second and third projections have a shape of one of spherical segment, flat truncated cone, and flat cylinder.
30. A floor covering according to Claim 28, wherein the second projections have the shape of the one of a square prism and a frustum with rounded edges and rounded areas adjoining underside of the covering and extending to a plane of the floor covering, and the third projections have the shape of a spherical segment.

31. A floor covering according to Claim 39, wherein a distance between opposite edges of each of the second projections correspond to at least a distance between adjacent second projections.
32. A floor covering according to Claim 39, wherein a distance between opposite edges of each of the third projections is less than a distance between adjacent third projections.
33. A floor covering according to Claim 32, wherein the distance between the opposite edges each of third projections is less than 3/4 of the distance between the adjacent third projections.
34. A floor covering according to Claim 39, wherein grid sizes of arrangements of the first and second projections essentially correspond, and a grid size of the third projections corresponds to the grid size of the arrangements of the first and second projections or a multiple thereof.
36. A floor covering according to Claim 39, wherein a height of the first projections is less than 1/3 of a largest dimension thereof in a covering plane

and a height of at least one of a second and third projections is in a range of between 15 and 1/ of a dimension thereof in a plane of the floor covering.

37. A floor covering according to Claim 39, further comprising at least one of perforations provided between the first and second projections and recesses formed in the underside.
38. A floor covering according to Claim 39, wherein at least one of the perforations and the recesses have one of a circular cross-section and a cross-section of a segment.
39. A floor covering made of an elastically deformable material, comprising an upper side; an underside; first projections regularly arranged on the upper side; second projections regularly arranged on the underside for supporting the floor covering on a floor, the first and second projections having no overlapping regions in a plane of the floor covering; and third projections provided on the underside, arranged between the second projections, and having, in an unstressed state of the floor covering, a height smaller than a height of the second projections, whereby the third projections provide for an additional support of the floor covering on the floor when a load applied

to the floor covering exceeds a predetermined value, wherein the third projections have a load dependent increasing characteristic line of rigidity whereby a progressive cushioning characteristic of the third projections is obtained.

40. A floor covering according to Claim 39, wherein the first projections are formed by superimposition of two basic geometric forms including a larger spherical segment and a smaller spherical segment mounted on the larger spherical segment.

APPENDIX "B"

Cases Appellant relies on:

1. *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*,
15 U.S.P.Q. 2d, 1525, 1528 (Fed. Cir. 1990).
2. *In re Wilson*, 165 U.S.P.Q. 494, 496 (CCPA 1970).